

REMARKS

Reconsideration and allowance of the subject application are respectfully solicited.

Claims 1, 4, 7, 17, 19, and 20 are pending, with Claim 1 being independent. Claims 11, 13, 15, 18, and 21 have been cancelled without prejudice. Claims 1, 19, and 20 have been amended.

The March 24, 2004 Amendment was objected to under 35 U.S.C. § 132 on the grounds that it introduces new matter, viz, the recitation regarding the “principal ray”. The Official Action states that the specification refers to “a ray of off-axis primary light” but does not discuss a “principal ray”. All objections are respectfully traversed and are submitted to have been obviated by the amendment of the claims to recite the --ray of off-axis primary light-- which, as acknowledged by the Official Action, finds in haec verba antecedent basis in the specification.

Claims 1, 4, 7, 11, 13, and 17 through 21 were rejected under 35 U.S.C. § 112, 1st paragraph, as lacking written description on the grounds that: (a) if the first diffractive part has a positive power, the light will be converged and therefore cannot reduce the incident angle; (b) if the first diffractive part has a negative power, the light will be diverged and the angle may either be increased or reduced by the diffractive action; and (c) the light ray does not have an incident angle between plus and minus 6 degrees which is a criterion for achieving the claimed features. All rejections and grounds thereof are respectfully traversed.

As regards (a), Applicant respectfully submits that the ground of rejection has been obviated by the cancellation without prejudice of Claims 11, 13, 15, 18, and 21.

As regards (b), Applicant respectfully submits that the ground of rejection has been obviated by the amendment of the claims in a manner earnestly believe to avoid the ground of rejection, viz, the claims have been amended to recite that the --first diffraction part and the second diffraction part are configured to reduce-- the incident angle, as Applicant understands the Official Action's position to be that the configuration of the second diffraction part plays a role in the incident angle.

As regards (c), the "6 degrees" assertion is respectfully traversed by Applicant. As regards written description, Applicant respectfully submits that there has been no showing that the artisan would have concluded that Applicant regarded said feature, which was not recited in the original claims, as essential. MPEP 2163.05, 2163.04. As regards enablement, Applicant submits that the disclosure fully enables one of ordinary skill in the art to make and use the claimed invention without undue experimentation. There has been no showing of any evidence or reasons to the contrary. See MPEP 2164.04 (citing In re Wright, 27 USPQ2d 1510 (Fed. Cir. 1993)), and MPEP 2164.08. Absent any such evidence or reasons it is respectfully submitted that the rejection is not well-founded. Furthermore, it will be appreciated that a rejection for undue breadth is not appropriate if one of ordinary skill can ascertain which embodiments encompassed by the claim are operative without undue experimentation. See In re Wands, 8 USPQ2d 1400, 1404 (Fed. Cir. 1988). Working examples are not required for enablement, and even considerable experimentation is not considered undue if the specification provides a reasonable amount of guidance with respect to the direction in which experimentation should proceed. *Id.* It is also well-settled that the claims are not limited to the disclosed embodiments. See In re Dihn-Nguyen, 492 F.2d 856, 858-859. MPEP 2164.04, 2164.08. Lastly, features that are preferred are not to be considered critical. MPEP 2164.08(c).

Claims 19 and 20 were objected to for informalities, viz, the use of the expression “the object side” and “the image side”. All objections are respectfully traversed and are submitted to have been obviated by the amendment of the claims in a manner earnestly believed by Applicant to avoid the grounds of objection, viz, “the object side” has been replaced with --a front side-- and “the image side” has been replaced with --a rear side--.

Claims 1, 4, 7, 19, and 20 were rejected under 35 U.S.C. § 103 over U.S. Patent No. 6,052,234 (Mukai, et al.) in view of U.S. Patent No. 6,157,488 (Ishii). The Official Action makes the following assertions: (a) Mukai, et al.’s real image viewfinder optical system can be used in a camera, which is an imaging optical system (Official Action, page 4, paragraph 9); (b) Mukai, et al. shows a refractive optical element on the image side of the pupil in Fig. 10 (Official Action, page 5, paragraph 9); and (c) Mukai, et al. discloses a pupil at position “he” in Fig. 7 that constitutes the claimed pupil (Official Action, page 6, paragraph 13). And in the previous Official Action, it was asserted that Mukai, et al. fails to show that the parts are made of materials having dispersion characteristics different from each other, and Ishii was relied upon as showing such a feature. All rejections and assertions are respectfully traversed.

Claim 1 recites, inter alia, that the layered diffraction optical member with the claimed dispersions is provided in front of a pupil --of the imaging optical system--, in combination with the feature that the imaging optical system --forms an image on an image plane with light that has passed through said layered diffraction optical member--.

However, Applicant respectfully submits that neither Mukai, et al. nor Ishii, even in combination, assuming, arguendo, that the documents could be combined, discloses or suggests at least the above-discussed combination of features as recited, inter alia, in Claim 1. In this regard, Applicant respectfully submits that (a) the whole system in Fig. 7 of Mukai, et al. is a

viewfinder optical system that is not an imaging optical system as claimed, (b) in Fig. 7 of Mukai, et al., the pupil plane of the objective optical system tg (the conjugated plane with the pupil “he”) exists around the place between the lens unit g1 and the lens unit g2, i.e., the surface S2*[DOE:-] and the surface S3*[DOE:+] are placed to sandwich the pupil between them — and pupil “he” is not a pupil of an imaging optical system as claimed, and (c) Mukai, et al.’s Fig. 10 does not show a refraction optical member disposed on the rear side of the pupil, as recited in Claim 20; instead, the “front” is at the right side of that figure and the “rear” is at the left side of that figure. It is further respectfully submitted that there has been no showing of any indication of motivation in the cited documents that would lead one having ordinary skill in the art to arrive at the above-discussed combination of claimed features as recited, inter alia, in Claim 1.

Claims 11, 13, 15, and 18 were rejected under 35 U.S.C. § 103 over U.S. Patent No. 5,636,000 (Ushida, et al.) in view of Ishii. All rejections are respectfully traversed, and are submitted to have been mooted by the cancellation without prejudice of those claims.

The dependent claims are also submitted to be patentable because they set forth additional aspects of the present invention and are dependent from independent claims discussed above. Therefore, separate and individual consideration of each dependent claim is respectfully requested.

Applicant submits that this application is in condition for allowance, and a Notice of Allowance is respectfully requested.

Applicant's undersigned attorney may be reached in our Washington, D.C. office by telephone at (202) 530-1010. All correspondence should continue to be directed to our address listed below.

Respectfully submitted,

A handwritten signature in cursive script, reading "Daniel S. Glueck", is written over a horizontal line.

Attorney for Applicant
Daniel S. Glueck
Registration No. 37,838

FITZPATRICK, CELLA, HARPER & SCINTO
30 Rockefeller Plaza
New York, New York 10112-3800
Facsimile: (212) 218-2200
DSG/dc

DC_MAIN 176892v1